



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 09/363,499

Filing Date: July 29, 1999

Applicant: Sutton, et al

Group Art Unit: 2164

Examiner: J. Bergin

For: METHOD AND SYSTEM FOR
TRANSACTIONING AN ANONYMOUS
PURCHASE OVER THE INTERNET

**DECLARATION OF
DAVID B. SUTTON
UNDER 37 C.F.R. 1.131**

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In compliance with 37 C.F.R. §1.131, the purpose of this Declaration is to establish conception of the claimed invention in the above-identified patent application (hereinafter "the Subject Application") in the United States, prior to April 27, 1999, which is the filing date of the Wisdom reference (U.S. Patent No. 6,145,741) and subsequent diligence pursuing the claimed invention until a constructive reduction to practice as evidenced by the filing of the Subject Application. The Wisdom reference was cited by the Examiner in an Office Action dated May 7, 2002 for the Subject Application.

I, the undersigned, does hereby declare:

1. That I am one of the named inventors for the claimed subject matter of the Subject Application.

2. That prior to April 27, 1999, the inventors had conceived, in the United States, the subject matter claimed in the Subject Application.

3. That the attached document illustrates a mock up of an exemplary purchase card (attached as Exhibit A to this Declaration and with the dates blocked out) which bears a date prior to April 27, 1999 and evidences conception in the United States of the claimed invention prior to April 27, 1999 the filing date of the Wisdom reference.

4. To the extent that the attached document does not disclose the step involving the purchasing intermediary, I further declare that prior to April 27, 1999, the inventors had conceived, in the United States, that the purchasing cards in the Subject Application would be provided by a purchasing intermediary to a retail establishment for distribution to consumers.

5. That the invention was diligently pursued by the inventors from prior to April 27, 1999 to a subsequent constructive reduction to practice as evidenced by U.S. Patent Application Serial No. 09/363,499 which was filed on July 29, 1999.

6. That diligence was exhibited by numerous events which transpired from before April 27, 1999 to July 29, 1999; some of these events are highlighted below:

- 4/99 the inventors are developing a business plan for new products involving the subject matter claimed in the Subject Application, including researching existing product offerings;
- 4/99 the inventors initial contacted a patent attorney to inquiry about pursuing patent protection for the subject matter claimed in the Subject Application;
- 5/5/99 the inventors met with patent attorney to discuss pursuing patent protection for the subject matter claimed in the Subject Application;
- 5/14/99 the inventors requested an assessment as to the patentability of the subject claimed in the Subject Application in view of U.S. Patent No. 5, 884,272 (see facsimile attached as Exhibit B)
- 5/15 – 6/10 due to a backlog of other unrelated matters, the patentability assessment was taken up in substantially chronological order and completed within four weeks in accordance with counsel's standard business practice (note: assessment was performed by patent counsel having expertise in the subject matter);
- 6/11/99 patent counsel provided inventors an assessment as to the patentability of the subject claimed in the Subject Application in view of U.S. Patent No. 5, 884,272;

shortly thereafter inventors authorized patent counsel to begin preparing a patent application directed to the subject claimed in the Subject Application and patent counsel prepared a first draft of

a patent application over the next few weeks in accordance with counsel's standard business practice;


7/14/99 patent counsel provides first draft of patent application to the inventors for review (see letter attached as Exhibit C); and

7/22/99 subsequent to revising the patent application in accordance with comments received from the inventors, patent counsel provides inventors with a final draft of the patent application and formal application documents for execution by the inventors (see letter attached as Exhibit D).

7. That the inventors have never abandoned the patent application.

8. I hereby declare that all statements made herein are of my own knowledge and are true and that all statements on information and belief are believed to be true; and, further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Subject Application or any patent which issues thereon.

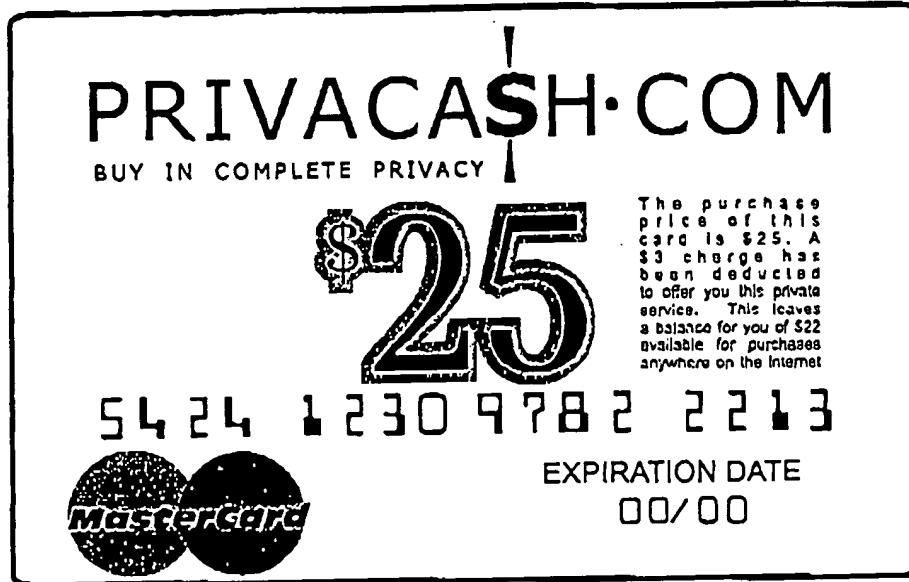
Dated: 7/7/03



David B. Sutton

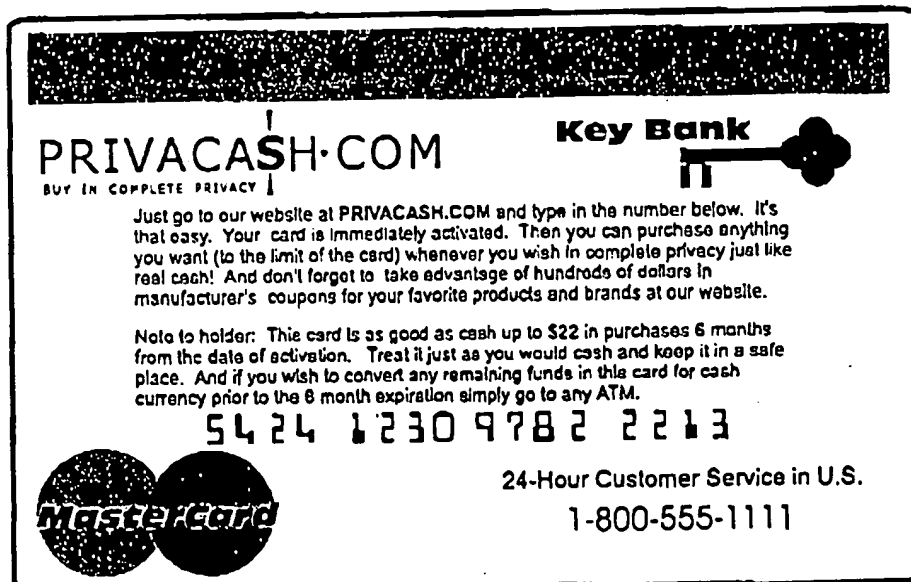
PrivaCard mock up

Front of Card



BEST AVAILABLE COPY

Back of Card



The card has been enlarged to show detail. The actual size will be the same as normal credit cards only with a common name.



VENTURE PARTNERS LLC

Te l e f a x

| | |
|-----------------------|-----------------------|
| To: Rich Carlson | From: Dave Sutton |
| Fax: (248) 641-0270 | Pages: 9 |
| Phone: (248) 641-1600 | Date: 5/14/99 2:12 PM |
| Re: | CC: Doug Blasiman |

☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

Rich--

I ran across this article in Forbes about the guy who came up with the idea for Priceline.com

It looks like he is working on an number of ideas which he intends to patent. I've noted one on page 185. It has nothing to do with our idea except that he has keyed in on the "anonymity" concept--and he could ultimately make the connection similar to our idea. I think we should make it a priority to get ours on file ASAP. Thanks, Dave.

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July 14, 1999

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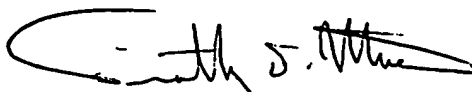
Re: U. S. Patent Application for a
"System For Preserving Purchaser Anonymity";
Our Reference No. 9204-000001

Dear Dave and Doug,

I am enclosing a first draft for the above-identified patent application. Please review the application for its technical accuracy and content. It is important that you thoroughly review this draft and make any necessary changes at this time, as new subject matter cannot be added after the application is filed.

During your review, please feel free to supplement the application and make additional changes or corrections that you believe will enhance the disclosure of the invention. When you are satisfied with the content of the application as well as the scope and variation of the claims, please return the marked-up application to me via facsimile. Alternatively, if you wish to discuss changes, please contact me at (248) 641-1286. If you have any additional comments or questions, please do not hesitate to contact me.

Very truly yours,



Timothy D. MacIntyre

TDM/gp
Enclosure

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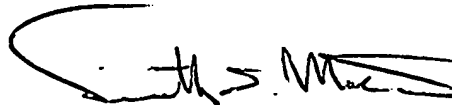
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Our Reference No. 9204-000001

Dear Dave and Doug,

Enclosed please find the original Declaration and Power of Attorney and a Verified Statement claiming small entity status relating to the above-identified patent application. Please execute and date each of the enclosed documents. Please return the original executed documents to me for filing with the U.S. Patent and Trademark Office.

If you have any questions regarding this matter, please feel free to contact me.

Very truly yours,



Timothy D. MacIntyre

TDM/gp
Enclosures